UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,028	10/03/2003	Daniel R. Malone	03-021	1498

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EXAMINER
DEBROW, JAMES J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/679,028	MALONE ET AL.
	Examiner	Art Unit	
	James J. Debrow	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C § 133)
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 September 2006</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213..

Disposition of Claims

4) ☒ Claim(s) <u>1,3-11 and 13-15</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 3-11, and 13-15</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communication: Amendments filled on 01 Sep. 2006.

2.   Claims 1, 3-11, and 13-15 are pending in this case. Claims 1, 8, 11, 13, 14, and

15 are independent claims.

Applicant's Response

3.   In Applicant's response dated 01 Sep. 2006, Applicant amended Claims 1, 3, 4,

8, and 11; cancelled claims 2 and 12; added new claims 14 and 15; argued against all

objections and rejection previously set forth in previous Office Action.

Claim Objections

4.   Claims 1 and 8 are objected to because of the following reason:

- the phase "electronic product template" in Line 1 should be deleted so that the

preamble reads more clearly.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claim 1, 3, 4-11, and 13-15 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Friedman et al. (Pub. No.: US 2003/0208556 A1; Filling Date:

Oct. 18, 1999) (hereinafter '<u>Friedman</u>'), in view of Fuwa et al. (Pub. No.: US

2005/0102151 A1; Filling Date: Dec. 25, 2001) (hereinafter '<u>Fuwa</u>').

         In regard to independent claim 1, Friedman discloses *a computer-implemented*

electronic product template method comprising

         receiving a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.).

         displaying the selected template to the user (0014, lines 7-8),

         providing one or more tools allowing the user to change at least one component

element of the template (0014, lines 9-12; 0015, lines 10-11; Friedman discloses the

user is able to customize the card by adding text, handwritten notes, graphics,

photographs and scanned data to the card.), *and*

         in response to each user change of a component element, associating the

element identifier of the new component element with the product description identifier

and modifying the displayed template to reflect the change (0019, lines 1-9; Friedman

teaches the modification to the card is viewed in a WYSIWYG format. It has been

established and is well known to a person of ordinary skill in the art that the WYSIWYG

format would allow the user to immediately view the modifications to the card as they

are made.)

Friedman does not disclose expressly *in response to the request, associating a*

product description identifier with a plurality of component element identifiers, each

component element identifier identifying a component element of the selected

template.

> *using at least some of the element identifiers associated with the product*

description identifier as element identifiers of a different template, and

> *display the different template to the user.*

However, Fuwa teaches *in response to the request, associating a product*

description identifier with a plurality of component element identifiers, each component

element identifier identifying a component element of the selected template (0037 –

0039; Fuwa teaches how products are classified into broad categories *(product*

description identifier), and each category is classified into sub-categories *(component*

element identifier).).

> *using at least some of the element identifiers associated with the product*

description identifier as element identifiers of a different template (0031; 0038; Fig. 2;

0044; Fig. 3; Fig. 15; Fuwa teaches/illustrates how sub-categories *(element identifiers)*

of one template can be used as a sub-category on a different template. Fuwa further

teaches a template database that stores files concerning stamp face designs. Using

the broadest interpretation of this teaching, the Examiner concludes that each different

template has a common element identifier in that the different templates are all stamps.

Even though the faces of the templates can me modified, the basic design element of

the template remains the same, as illustrated in Fig. 15.).

display the different template to the user (0034; Fuwa teaching the image

creating portion includes a preview creating portion, which creates preview image data

on a stamp face.).

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

In regard to dependent claim 3, Friedman discloses *the method of claim 2*

wherein the different template is template for a different side of the same product

currently being designed by the user (0074; 0086, lines 7-14; Fig 6B; Friedman

illustrates three different panel(sides) of a card in which the user can click on any panel

and selected panel will be displayed in an editable format.).

In regard to dependent claim 4, Friedman discloses *the method of claim 2*

wherein the different template is a template for a different product (0094-0096;

Friedman teaches that once changes to the card are accepted, the system

automatically presents the user a different web page (template) to specify information

related to the recipient. Friedman further teaches the user is provided a summary web

page (template), which the user can edit any information or add or delete the card.).

In regard to dependent claim 5, Friedman discloses *the method of claim 4*

wherein the template for the different product is created without user request (0094-

0096; Friedman teaches that once changes to the card are accepted, the system

automatically presents the user a different web page (template) to specify information

related to the recipient. Friedman further teaches the user is provided a summary web

page (template), which the user can edit any information or add or delete the card.).

In regard to dependent claim 6, Friedman discloses *the method of claim 5*

wherein the template for the different product is displayed to the user without user

request (0094-0096; Friedman teaches that once changes to the card are accepted,

the system automatically presents the user a different web page (template) to specify

information related to the recipient. Friedman further teaches the user is provided a

summary web page (template), which the user can edit any information or add or

delete the card.).

In regard to dependent claim 7, Friedman discloses *the method of claim 5*

further comprising providing a means whereby the user can initiate an order for the

production of the different product (0099; Friedman teaches how a credit card

transaction is used to produce and ship the order to the user.).

In regard to independent claim 8, Friedman discloses *a computer-implemented*

electronic product template method comprising (0126)

receiving a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.),

displaying the selected template to the user (0014, lines 7-8),

in response to user selection of one of the earlier product identifiers, associating

at least one of the component element identifiers of the selected earlier product with

the product description identifier and modifying the displayed template to reflect the

change (0019, lines 1-9; Friedman teaches the modification to the card is viewed in a

WYSIWYG format. It has been established and is well known to a person of ordinary

skill in the art that the WYSIWYG format would allow the user to immediately view the

modifications to the card as they are made.)

Friedman does not disclose expressly *in response to the request, associating a*

product description identifier with a plurality of component element identifiers, each

component element identifier identifying a component element of the selected

template.

displaying to the user identifiers associated with one or more earlier products

associated with the user, and

However, Fuwa teaches *in response to the request, associating a product*

description identifier with a plurality of component element identifiers, each component

element identifier identifying a component element of the selected template (0038 –

0039; Fuwa teaches how products are classified into broad categories *(product*

description identifier), and each category is classified into sub-categories *(component*

element identifier).).

displaying identifiers associated with one or more earlier products associated

with the user (0041-0042; Fuwa teaches the customer management database stores

information about customers who has order in the past, and the orders management

database stores information about the each order number and information about

orders.), *and*

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

In regard to dependent claim 9, Friedman discloses *the method of claim 8*
wherein the earlier product identifiers are thumbnail images of at least a portion of the
earlier products (0072; 0086; Fig. 6A; Friedman teaches to facilitate selection and
customization, card may be stored in a database as files in a thumbnail, intermediate
and editable size.).

In regard to dependent claim 10, Friedman discloses *the method of claim 8*
wherein the earlier product identifiers are displayed in response to a user request
(0086; Friedman teaches the user can select a card by clicking on the appropriate
thumbnail image of the card.).

In regard to independent claim 11, Friedman discloses *a computer program*
product embodied on a computer readable medium, the computer product comprising
computer code (0126) *adapted to*
     receive a user request to initiate a product design session using a selected
template (0014, lines 1-7; Friedman discloses the user may selects any of a number of
card templates stored in a database.),
     display the selected template to the user (0014, lines 7-8),
     provide one or more tools allowing the user to change at least one component
element of the template (0014, lines 9-12; 0015, lines 10-11; Friedman discloses the
user is able to customize the card by adding text, handwritten notes, graphics,
photographs and scanned data to the card.), *and*

in response to each user change of a component element, associate the element

identifier of the new component element with the product description identifier and

modify the displayed template to reflect the change (0019, lines 1-9; Friedman teaches

the modification to the card is viewed in a WYSIWYG format. It has been established

and is well known to a person of ordinary skill in the art that the WYSIWYG format

would allow the user to immediately view the modifications to the card as they are

made.).

Friedman does not disclose expressly *in response to the request, associate a*

product description identifier with a plurality of component element identifiers, each

component element identifier identifying a component element of the selected

template.

use at least some of the element identifiers associated with the product

description identifier as element identifiers of a different template, and

display the different template to the user.

However, Fuwa teaches *in response to the request, associating a product*

description identifier with a plurality of component element identifiers, each component

element identifier identifying a component element of the selected template (0038 –

0039; Fuwa teaches how products are classified into broad categories *(product*

description identifier), and each category is classified into sub-categories *(component*

element identifier).).

using at least some of the element identifiers associated with the product

description identifier as element identifiers of a different template (0031; 0038; Fig. 2;

0044; Fig. 3; Fig. 15; Fuwa teaches/illustrates how sub-categories *(element identifiers)*

of one template can be used as a sub-category on a different template. Fuwa further

teaches a template database that stores files concerning stamp face designs. Using

the broadest interpretation of this teaching, the Examiner concludes that each different

template has a common element identifier in that the different templates are all stamps.

Even though the faces of the templates can me modified, the basic design element of

the template remains the same, as illustrated in Fig. 15.).

display the different template to the user (0034; Fuwa teaching the image

creating portion includes a preview creating portion, which creates preview image data

on a stamp face).

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

In regard to independent claim 13, Friedman discloses *a computer program*

product embodied on a computer readable medium, the computer program product

comprising computer code (0126) *adapted to*

receive a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.),

display the selected template to the user (0014, lines 7-8),

in response to user selection of one of the earlier product identifiers, associate at

least one of the component element identifiers òf the selected earlier product with the

product description identifier and modifying the displayed template to reflect the

change (0019, lines 1-9; Friedman teaches the modification to the card is viewed in a

WYSIWYG format. It has been established and is well known to a person of ordinary

skill in the art that the WYSIWYG format would allow the user to immediately view the

modifications to the card as they are made.).

Friedman does not disclose expressly *in response to the request associate a*

product description identifier with a plurality of component element identifiers, each

component element identifier identifying a component element of the selected

template.

displaying to the user identifiers associated with one or more earlier products

associated with the user, and

However, Fuwa teaches *in response to the request associating a product*

description identifier with a plurality of component element identifiers, each component

element identifier identifying a component element of the selected template (0038 –

0039; Fuwa teaches how products are classified into broad categories *(product description identifier)*, and each category is classified into sub-categories *(component element identifier)*.).

displaying identifiers associated with one or more earlier products associated with the user (0041-0042; Fuwa teaches the customer management database stores information about customers who has order in the past, and the orders management database stores information about the each order number and information about orders.)*, and*

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a product description identifier (product categories) with component element identifiers (product sub-categories).

In regard to independent claim 14, Friedman discloses *an electronic product template system comprising*

means for receiving a user request to initiate a product design session using a selected template (0014, lines 1-7; Friedman discloses the user may selects any of a number of card templates stored in a database.).

means for providing the selected template for displaying to the user (0014, lines 7-8).

means for providing one or more tools allowing the user to change at least one component element of the template (0014, lines 9-12; 0015, lines 10-11; Friedman discloses the user is able to customize the card by adding text, handwritten notes, graphics, photographs and scanned data to the card.).

means responsive to each user change of a component element, for associating the element identifier of the new component element with the product description identifier and for modifying the template to reflect the change (0019, lines 1-9; Friedman teaches the modification to the card is viewed in a WYSIWYG format. It has been established and is well known to a person of ordinary skill in the art that the WYSIWYG format would allow the user to immediately view the modifications to the card as they are made.).

Friedman does not disclose expressly *means responsive to the request for associating a product description identifier with a plurality of component element identifiers, each component element identifier identifying a component element of the selected template;*

means for using at least some of the element identifiers associated with the product description identifier as element identifiers of a different template, and

means for providing the different template to the user.

However, Fuwa teaches *means responsive to the request for associating a product description identifier with a plurality of component element identifiers, each*

component element identifier identifying a component element of the selected template

(0037 – 0039; Fuwa teaches how products are classified into broad categories *(product*

description identifier), and each category is classified into sub-categories *(component*

element identifier).);

    means for using at least some of the element identifiers associated with the

product description identifier as element identifiers of a different template (0031; 0038;

Fig. 2; 0044; Fig. 3; Fig. 15; Fuwa teaches/illustrates how sub-categories *(element*

identifiers) of one template can be used as a sub-category on a different template.

Fuwa further teaches a template database that stores files concerning stamp face

designs. Using the broadest interpretation of this teaching, the Examiner concludes

that each different template has a common element identifier in that the different

templates are all stamps. Even though the faces of the templates can me modified, the

basic design element of the template remains the same, as illustrated in Fig. 15.).

    means for providing the different template to the user (0034; Fuwa teaching the

image creating portion includes a preview creating portion, which creates preview

image data on a stamp face.).

    Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

 In regard to independent claim 15, Friedman discloses *an electronic product*

template system comprising

means for receiving a user request to initiate a product design session using a

selected template (0014, lines 1-7; Friedman discloses the user may selects any of a

number of card templates stored in a database.).

 means for providing the selected template for displaying to the user (0014, lines

7-8).

 means for providing identifiers associated with one or more earlier product

associated with the user for displaying to the user (0041-0042; Fuwa teaches the

customer management database stores information about customers who has order in

the past, and the orders management database stores information about the each

order number and information about orders.).

 means responsive to user selection of one of the earlier product identifiers for

associating at least one of the component element identifiers of the selected earlier

product with the product description identifier and for providing a modified template

reflecting the change for displaying to the user (0019, lines 1-9; Friedman teaches the

modification to the card is viewed in a WYSIWYG format. It has been established and is

well known to a person of ordinary skill in the art that the WYSIWYG format would allow

the user to immediately view the modifications to the card as they are made.).

 Friedman does not disclose expressly *means responsive to the request for*

associating a product description identifier with a plurality of component element

identifiers, each component element identifier identifying a component element of the

selected template,

However, Fuwa teaches *means responsive to the request for associating a*

product description identifier with a plurality of component element identifiers, each

component element identifier identifying a component element of the selected template

(0037 – 0039; Fuwa teaches how products are classified into broad categories *(product*

description identifier), and each category is classified into sub-categories *(component*

element identifier).);

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

Note

7.   It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the reference should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Response to Arguments

8.   Applicant's arguments filed 01 Sep. 2006 in reference to the prior art rejection,

have been fully considered but they are not persuasive. However, the Examiner

withdraws all 35 U.S.C. 101 rejections.

Applicant argues there is no suggestion in Friedman of associating a product

description identifier with a plurality of component element identifiers and then using at

least some of the element identifies as element identifiers era different template, as

claimed in claims 1, 11, and 14, nor does Friedman teach receiving a user request to

initiate a product design session using a first template and then replacing at least one of

the template component element identifiers in that template with other component

identifiers from an earlier product associated with that user, as claimed in claims 8, 13

and 15.

The Examiner disagrees.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ

871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Fuwa teaches *in response to the request, associating a product description*

identifier with a plurality of component element identifiers, each component element

identifier identifying a component element of the selected template (0037 – 0039; Fuwa

teaches how products are classified into broad categories *(product description*

identifier), and each category is classified into sub-categories *(component element*

identifier).).

using at least some of the element identifiers associated with the product

description identifier as element identifiers of a different template (0031; 0038; Fig. 2;

0044; Fig. 3; Fig. 15; Fuwa teaches/illustrates how sub-categories *(element identifiers)*

of one template can be used as a sub-category on a different template. Fuwa further

teaches a template database that stores files concerning stamp face designs. Using

the broadest interpretation of this teaching, the Examiner concludes that each different

template has a common element identifier in that the different templates are all stamps.

Even though the faces of the templates can me modified, the basic design element of

the template remains the same, as illustrated in Fig. 15.).

display the different template to the user (0034; Fuwa teaching the image

creating portion includes a preview creating portion, which creates preview image data

on a stamp face.).

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James J. Debrow whose telephone number is 571-272-

5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JAMES DEBROW
EXAMINER
ART UNIT 2176

DOUG HUTTON
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